

**UNITED STATES DEPARTMENT OF COMMERCE****United States Patent and Trad mark Office**Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231*AS*

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
|-----------------|-------------|----------------------|---------------------|
|-----------------|-------------|----------------------|---------------------|

08/894,824 08/29/97 FRIEDE

R BAYER9930-WC

IM22/0709

WILLIAM C. GERSTENZANG  
NORRIS, MC LAUGHLIN & MARCUS, P.A.  
220 EAST 42ND STREET  
30TH FLOOR  
NEW YORK NY 10017

EXAMINER

|          |              |
|----------|--------------|
| MOORE, M |              |
| ART UNIT | PAPER NUMBER |

1712  
DATE MAILED:

28

07/09/01

Please find below and/or attached an Office communication concerning this application or proceeding.

**Commissioner of Patents and Trademarks**

## Office Action Summary

|                               |                            |
|-------------------------------|----------------------------|
| Application No.<br>08/894,824 | Applicant<br>Friebe et al. |
| Examiner<br>Margaret Moore    | Art Unit<br>1712           |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1)  Responsive to communication(s) filed on Apr 26, 2001
- 2a)  This action is FINAL.      2b)  This action is non-final.
- 3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

- 4)  Claim(s) 1 to 4, 6 and 8 to 13 is/are pending in the application.
- 4a) Of the above, claim(s) 11 and 12 is/are withdrawn from consideration.
- 5)  Claim(s) \_\_\_\_\_ is/are allowed.
- 6)  Claim(s) 1 to 3, 6, 8 to 10 and 13 is/are rejected.
- 7)  Claim(s) 4 is/are objected to.
- 8)  Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9)  The specification is objected to by the Examiner.
- 10)  The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved.
- 12)  The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

- 13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a)  All b)  Some\* c)  None of:

1.  Certified copies of the priority documents have been received.
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

- 15)  Notice of References Cited (PTO-892)      18)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 16)  Notice of Draftsperson's Patent Drawing Review (PTO-948)      19)  Notice of Informal Patent Application (PTO-152)
- 17)  Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_      20)  Other: \_\_\_\_\_

Art Unit: 1712

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1 to 3, 6, 8 to 10 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schiller et al. in view of Sattlegger et al. for reasons of record.

3. Claims 1 to 3, 6, 8 to 10 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eck et al. in view of Sattlegger et al.

Since applicants rely on the same rationale in overcoming these rejections, the Examiner will address them simultaneously.

In an effort to advance prosecution, applicants argue that they have amended claim 1 to limit the definition of the phosphorus compound “in the same sense” as the limitations of claim 4. This, however, is not an accurate description of the amendment. Claim 4 provides a very limited definition of R<sup>3</sup>, such that the phosphoric acid ester must include either 1) an R<sup>3</sup> group that is a linear or branched C<sub>4</sub> to C<sub>30</sub> alkyl group *and* an R<sup>3</sup> group that is a silyl radical (for when n is 0) or 2) an R<sup>3</sup> group that is a linear or branched C<sub>4</sub> to C<sub>30</sub> alkyl group *and* an -OH radical.

The amendment to claim 1 does not limit the phosphoric acid ester “in the same sense” as the limitation to claim 4. For instance, in claim 1 as amended, when n is 0, all R<sup>3</sup> groups can be silyl radicals. This amendment in no way overcomes the rejection based on Eck et al., who teach phosphoric acid esters having silyl groups. Also, in claim 1 as amended, when n is 1 or 2, the R<sup>3</sup> group can be any member of a very large selection of groups and no picking or choosing from the teachings of Schiller et al. is required to arrive at members of this large group.

As such, this amendment fails to overcome the rejections of record. As noted, claim 4 would be allowable if amended to be an independent claim.

Art Unit: 1712

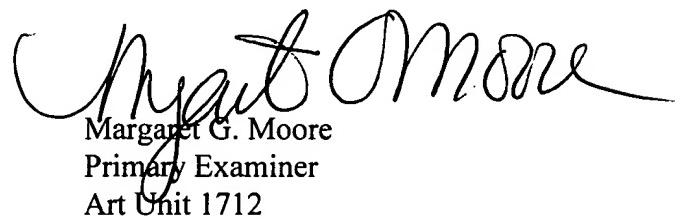
4. With respect to applicants' request to rejoin the non-elected claims, the Examiner notes that even in the event that the pending claims were allowed, the non-elected claims would not be rejoined. They are not of the same scope as the pending claims and they are drawn to different subject matter than the pending claims and would require a completely new search and examination. Note too that the instant claims were elected without traverse.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication should be directed to Margaret G. Moore at telephone number (703) 308-4334.

Any **official** documents (after final rejection) can be faxed to (703) 872-9310. All other **official** faxes should be sent to (703) 872-9311. Please do not send any informal communication or proposed amendments to this number.



Margaret G. Moore  
Primary Examiner  
Art Unit 1712

mgm  
July 6, 2001